

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

In order to perfect applicants priority claim, enclosed herewith is a verified translation of the priority document, JP 2001-022663, which was filed on January 31, 2001. It is noted that the Sohrab patent, which is used in combination with the El-Hage et al. patent and the King et al. patent, is based upon an application that was filed June 12, 2001. Therefore, it is respectfully submitted that the Sohrab patent is not a reference against the present application. Insofar as all of the rejections of claims 3 and 16 depend upon the Sohrab patent, it is considered apparent that, upon removal of the Sohrab patent as a reference by perfecting the applicant's priority claim, claims 3 and 16 should be in an allowable condition. Notice to that effect is hereby requested.

Claim 5 is the only claim remaining at issue in the present application. Claim 5 has been rejected as being unpatentable over US 5,843,378 to El-Hage et al. in view of US 2005/0017099 to Batich et al. or US 5,938,604 to Wagner et al.

El-Hage is cited for teaching an auto sampler having a plurality of sample vessels and a probe, which the Examiner has referred to as the needle of claim 5. The El-Hage needle or probe is formed from stainless steel, but is not coated with a non-noble metal including nickel or chromium. The Examiner has cited Batich and Wagner as teaching forming a nickel or chromium coating on a surface of a needle.

For the following reasons, the Examiner's rejections are traversed.

In order to properly combine two references in making a rejection under 35 USC 103, the Examiner must establish some motivation or suggestion in the art of record, or generally known to those skilled in the art, that would lead one skilled in the art to combine the references in the manner required to arrive at the claimed invention. It is respectfully submitted that the required motivation is lacking in the present case.

El-Hage is directed toward a sampling device, and includes a probe that is adapted to draw and dispense samples.

Batich is directed toward a needle that is useful for atomizing liquids, which may be desirable in CCVD atomizers.

Wagner is directed toward a radioactive needle that is useful in nuclear imaging techniques to help identify and localize abnormalities that are otherwise difficult to image.

It is respectfully submitted that there is no reason, apart from the present application, to combine the El-Hage auto sampler with the CCVD atomizer needle of Batich or the radioactive nuclear imaging needle of Wagner. It is considered apparent that one skilled in the art of auto samplers, when trying to improve such auto samplers, would not look to the aerosol formation art or the nuclear imaging art.

Further, it is unclear why one skilled in the art of auto samplers, such as taught by El-Hage, would be motivated to combine the aerosol forming needle of Batich or the nuclear imaging needle of Wagner, so as to arrive at an auto sampler having a needle that has an extra coating layer. Clearly, the problems encountered in the device of El-Hage are completely different than those encountered by Batich and

Wagner. It is submitted that no motivation or suggestion to combine the references can be found in the art of record. As such, it must be concluded that the present application provides the only motivation to combine and, as such, the rejection of claim 5 based upon these references is invalid for hindsight, and must be withdrawn.

It is further noted that the Examiner's statement "It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the stainless steel needle of El-Hage may be modified by coating it with nickel or chromium as taught by Batich et al. in order to employ a less corrosive needle or narrow its bore" is without merit. There is no suggestion in El-Hage of any problem with stainless steel needles being 'corrosive' or having too large of a bore, as would be necessary to support the Examiner's conclusions. In fact, there are no such problems. Further, as noted above, it is unclear to the undersigned why or how one skilled in the art would be motivated to combine the Batich needle (with a narrowed inner diameter at its tip to facilitate atomization of liquids) with the apparatus of El-Hage. Insofar as there is no reason, apart from the present application, to combine the references in this manner, the rejection must be withdrawn.

It is further noted that the Examiner's statement "It would have been obvious to one of ordinary skill at the time of the invention modify the stainless steel needle of El-Hage to include a nickel coating in order to prevent the decomposition of the stainless steel" is without merit. There is no suggestion in El-Hage of any problem with stainless steel decomposition. In fact, there is no such problem. The outer layer in Wagner is provided to prevent reaction and wear of the radioactive material later, not the stainless steel base. The problem identified and addressed by the present invention is a problem with cross-contamination, not decomposition. Insofar

as none of the cited art teaches the problem of stainless steel needle decomposition, it is difficult for the undersigned to understand how it would have been obvious to coat the needle with nickel to solve this unknown problem.

Claim 5 also stands rejected as being unpatentable over King in view of Batich. King is cited for teaching a sample handling system. Batich is cited for teaching a needle. For the following reasons, the Examiner's rejection of claim 5 based upon this combination of references is traversed.

It is respectfully submitted that there is no motivation to combine the King and Batich references in the manner proposed by the Examiner. Simply put, and as noted hereinbefore, one skilled in the art of sample handling equipment would not look to the art of atomizing needles when trying to improve upon the sample handling apparatus. Further, insofar as King neither mentions nor suggests any problem with the sample needles or probes used therein, and Batich is unrelated to sample needles or probes, there is no reason, apart from the present application, that would lead one skilled in the art to combine the references in the manner advocated by the Examiner. Rather, it is considered apparent that the present application provides the only motivation for the combination of references and, as such, this combination is invalid for hindsight and should be withdrawn.

Although not listed, it appears that the Examiner also intended to reject claim 5 as being unpatentable over King in view of Wagner. It is noted that the arguments set forth hereinbefore regarding the combination of El-Hage and Wagner also apply to the proposed combination of King and Wagner. Namely, except for the present application, there is no motivation to combine the King and Wagner references in the manner proposed by the Examiner. Accordingly, one skilled in the art would not

have been motivated to combine King and Wagner. The Examiner has failed to establish a sustainable rejection under 35 USC 103. Reconsideration and withdrawal of the rejection based upon King and Wagner is requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NGB-12930.

Respectfully submitted,

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